

AMENDMENT UNDER 37 C.F.R. §1.116
U.S. Appln. No. 09/845,355

REMARKS

Claims 11-20 are all the claims pending in the application.

Support for the amendment to claim 11 may be found in the specification as originally filed, for example, at page 68. New claims 12-20 contain the same subject matter as previously pending claims 2-10. Therefore, new claims 12-20 do not raise issues of new matter and do not raise issues that require further consideration or search. Consideration and entry of the present amendment are requested.

I. The Rejections Under 35 U.S.C. §103(a)

Claims 1-11 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the combination of Miyamoto et al (Miyamoto) and Hioki et al (Hioki).

Claims 1-6 and 9-11 are rejected under 35 U.S.C. §103 as allegedly being unpatentable over Hioki.

The Examiner maintains his position that it would have been obvious to use two types of dyes, both within the scope of formula (I) together in a silver halide emulsion. Additionally, the Examiner criticizes the Declaration for three reasons.

First, the Examiner states that Applicants fail to make a comparison to the closest prior art of record. In particular, the Examiner states that the samples of Example 1, Table 1, column 35, of Miyamoto et al is the closest prior art of record.

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Second, the Examiner states that the results shown in the Declaration are not commensurate with the scope of the claimed invention. In particular, the Examiner notes that Sample No. 201 of Example 2 of the present specification is related to a multilayer silver halide color photographic material. The Examiner states that the silver halide emulsion as claimed can be used in a black and white photographic material and the Examiner states that the material of Example 1 of Miyamoto is a black and white photographic material.

Third, the Examiner states that the improvement of the sensitivity would have been expected from the use of dye of Miyamoto. In particular, the Examiner notes Samples 106 to 108 of Miyamoto and states that the data of Table 1 of Miyamoto shows materials having sensitivities higher than that presented in the Declaration.

Applicants respectfully submit that the present invention is not anticipated by or obvious over Hioki alone or over Miyamoto and Hioki and request that the Examiner reconsider and withdraw these rejections in view of the following remarks.

As noted by the Examiner Example 1 of Miyamoto et al shows samples of single layer emulsions containing sensitizing dyes, which are processed by black and white development. To the contrary, Applicants' claims recite a "silver halide color photographic material".

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Additionally, Applicants respectfully submit that the §132 Declaration is commensurate in scope with the claimed subject matter.

As to the Examiner's statement that the sensitivity values shown in some of the samples of Miyamoto are larger than those shown in the Declaration, Applicants note that the sensitivity data of Table 1 of Miyamoto are relative sensitivity values, which are relative to the particular material of Sample 101 of Miyamoto. Thus, it is respectfully submitted that the comparison of sensitivity data made by the Examiner is not an appropriate comparison. That is, the standard (i.e., base of comparison) for the data of Miyamoto is clearly different from the sensitivity values of the data in the §132 Declaration. Accordingly, Applicants respectfully submit that the sensitivity data of Table 1 of Miyamoto can not be properly compared to the sensitivity values in the data of the §132 Declaration.

The Examiner is requested to review and reevaluate the comparative data of the §132 Declaration. In particular, the comparison between Sample 206 (Invention) according to the present invention and Sample 203 (Comparison) and 214 (Comparison) having the constitution of dye according to Miyamoto, shown in Table 3' of the §132 Declaration is evidence of the unexpected superiority of the present invention.

Further to the rejection based on Hioki, Hioki does not disclose the constitution of the present invention using two kinds of different dyes represented

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by formula (I) of the present invention or that both high sensitivity and reduced residual color may be obtained by such a constitution of the present invention, as claimed.

In previous §132 Declaration, the unexpected effect of the present invention obtained by the combination of the dyes according to the present invention is demonstrated by comparing with the combination of the dyes specifically described in Hioki. Thus, Applicants respectfully submit that Applicants have compared with the closest cited art.

The combination of the dyes of Hioki corresponds to Sample 303 in Table 4 of the previous Declaration (See the representative example of formula (I): Compound No. (1) and the representative example of formula (II): Compound No. (75)).

The combination of Dyes S-1 and S-2 used in the example of Hioki corresponds to Sample 214 in Table 3' of the previous Declaration.

Applicants' respectfully submit that Miyamoto does not teach or disclose the use of two types of dyes, both within the scope of formula (I) together in a silver halide emulsion. Likewise, Hioki does not teach or disclose the use of two types of dyes, both within the scope of formula (I) together in a silver halide emulsion. Moreover, even if the cited references are combined Applicants' invention would not be obtained. Therefore, it is respectfully submitted that the Examiner has not

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established a *prima facie* case of obviousness in view of the disclosures of Hioki alone or in view of the disclosures of Miyamoto and Hioki together.

Further, Applicants have established the unexpected superiority of the presently claimed invention over the materials disclosed in Miyamoto and Hioki.

For the above reasons, it is respectfully submitted that the subject matter of claims 11-20 is neither taught by nor made obvious from the disclosures of Hioki et al alone or Miyamoto and Hioki and it is requested that the rejections under 35 U.S.C. §103(a) be reconsidered and withdrawn.

II. Conclusion

In view of the above, Applicants respectfully submit that their claimed invention is allowable and ask that rejections under 35 U.S.C. §103 be reconsidered and withdrawn. Applicants respectfully submit that this case is in condition for allowance and allowance is respectfully solicited.

If any points remain at issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the local exchange number listed below.

Applicants hereby petition for any extension of time which may be required to maintain the pendency of this case.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


Lee C. Wright

Registration No. 41,441

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE



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PATENT TRADEMARK OFFICE

Date: January 31, 2003

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APPENDIX
VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claims 1-10 are canceled.

The claims are amended as follows:

11 (twice amended). A silver halide color photographic material which comprises a support having provided thereon at least one emulsion layer containing the silver halide photographic emulsion which contains at least two different sensitizing dyes represented by the following formula (I):



wherein Dye represents a dye moiety; A represents a linking group; Q represents a dissociable group; r represents 0 or 1; q represents an integer of 2 or more, provided that at least one Q represents $-\text{SO}_3\text{H}$ and at least one Q represents a dissociable group other than $-\text{SO}_3\text{H}$; M represents a counter ion; and m represents a number of 0 or more necessary to neutralize the electric charge in the molecule, and when m represents 2 or more, M's need not be the same.

Claims 12-20 are added as new claims.